

REMARKS/ARGUMENTS

The rejections presented in the Office Action dated December 4, 2007 (hereinafter Office Action) have been considered but are believed to be improper. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

Applicant respectfully traverses each of the prior art rejections (§§ 102(e) and 103(a)) which are based at least in part upon the teachings of U.S. Publication No. 2002/0099727 by Kadyk *et al.* (hereinafter “Kadyk”) because Kadyk alone, or in combination, does not teach or suggest each of the claimed limitations. For example, Kadyk fails to at least teach a configuration message that is transmitted prior to a synchronization procedure, as claimed in each of the independent claims. In contrast, the asserted update notifications of Kadyk are sent during synchronization, “To synchronize data 282 with data 242, server 210 creates update notifications” (paragraph [0047]). Also, paragraph [0053] states that “Synchronization begins with the step of a server computer providing notifications (320).” The claimed configuration messages include data that is received, stored, and then retrieved in order to initialize synchronization whereas Kadyk’s update notifications are sent as part of a synchronization. Since Kadyk’s update notifications are sent during synchronization any data contained therein would not be used to initialize a synchronization; therefore, the asserted update notifications cannot correspond to the claimed configuration message. Without correspondence to each of the claimed limitations, the prior art rejections are improper.

With particular respect to the § 102(e) rejection, Applicant notes that to anticipate a claim the asserted reference must teach every element of the claim. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the patent claim; *i.e.* every element of the claimed invention must be literally present, arranged as in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). Therefore, all claim elements, and their

limitations, must be found in the prior art reference to maintain the rejection based on 35 U.S.C. § 102. Applicant respectfully submits that Kadyk does not teach every element of at least independent Claims 1, 10, 12, 14 and 19-22 in the requisite detail and therefore fails to anticipate at least Claims 1-3, 5, 10-14, 16, 17 and 19-22. Applicant accordingly requests that the rejection be withdrawn.

In addition, Kadyk further fails to teach configuration messages comprising data including settings of at least a second database, as claimed in each of the independent claims. In contrast to the claimed settings of a database, the asserted tokens identify specific data items (and changes to them) to be synchronized (paragraph [0032]). Kadyk's tokens are used during synchronization operations to identify missing changes; thus, the tokens relate to the data subject to synchronization and not settings of a database used in initializing a synchronization procedure, as claimed. Without a presentation of correspondence to each of the claimed limitations, the rejections are improper, and Applicant accordingly requests that they be withdrawn.

Moreover, dependent Claims 2, 3, 5, 11, 13, 16 and 17 depend from independent Claims 1, 10, 12 and 14, respectively, and also stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Kadyk. While Applicant does not acquiesce to the particular rejection to these dependent claims, the rejection is also improper for the reasons discussed above in connection with the independent claims. These dependent claims include all of the limitations of their respective independent claims, and recite additional features which further distinguish them from the cited reference. Therefore, the rejection of dependent Claims 2, 3, 5, 11, 13, 16 and 17 is improper. Applicant accordingly requests that the § 102(e) rejection be withdrawn.

Regarding the § 103(a) rejections of dependent Claims 4, 6-9, 15 and 18 based upon Kadyk in view of U.S. Patent No. 6,308,201 to Pivowar *et al.* (hereinafter "Pivowar"), U.S. Patent No. 6,643,669 to Novak *et al.* (hereinafter "Novak"), and U.S. Publication No. 2002/0081995 by Leppinen *et al.* (hereinafter "Leppinen"), respectively, Applicant respectfully traverses. As discussed above, Kadyk fails to correspond to the limitations of independent Claims 1 and 14 (from which Claims 4, 6-9, 15 and 18 depend). The further

reliance on Pivowar, Novak, and Leppinen does not overcome the above-discussed deficiencies in the underlying reference. Thus, the asserted combinations of the teachings of Kadyk with Pivowar, Novak, and Leppinen do not teach each of the claimed limitations of dependent Claims 4, 6-9, 15 and 18, and the rejections should be withdrawn.

With further respect to the rejection of Claims 6-8 and 18 based in part upon Leppinen, Applicant traverses because Leppinen is not an available reference for § 103(a) rejections in view of 35 U.S.C. § 103(c). Section 103(c) indicates that subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of 35 U.S.C. § 102 shall not preclude patentability where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. MPEP § 706.01(l)(1). First, Leppinen is not available as a reference under § 102(a) or (b) because the publication date (June 27, 2002) is later than at least the filing date of the present application's parent application (March 25, 2002). Leppinen is also not available as a reference under § 102(c) or (d). Thus, Leppinen must be asserted based upon § 102(e), (f), and/or (g).

Second, Leppinen was, and is, owned by Nokia Inc. as a result of the assignment recorded at Reel/Frame No. 011773/0949 on April 26, 2001 (corrected on September 24, 2001). The inventors of the instant invention were also subject to an obligation to assign the instant invention to Nokia Corporation at the time the invention was made. That obligation was fulfilled as evidenced by the assignment of the instant application to Nokia Corporation recorded at Reel/Frame No. 014733/0705 on June 15, 2004. In view of the above-evidenced common ownership, Leppinen is not available as a § 103(a) reference thereby rendering the rejection of Claims 6-8 and 18 improper. Applicant accordingly requests that the rejection be withdrawn.

It should also be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's

invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

New Claims 23-44 have also been added. These claims largely correspond to original Claims 2-9, 12 and 14; therefore, the new claims do not introduce new matter. Each of the new claims is believed to be patentable over the asserted references for the reasons set forth above in connection with the independent claims.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.053PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact the undersigned attorney to discuss any issues related to this case.

Respectfully submitted,

HOLLINGSWORTH & FUNK, LLC
8009 34th Avenue South, Suite 125
Minneapolis, MN 55425
952.854.2700

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By: 

Erin M. Nichols
Reg. No. 57,125